

**REMARKS**

The comments of the Examiner as set forth in the Office Paper mailed 9 May 2005 have been carefully studied and reviewed.

Claims 1-30 are pending in the application.

Claims 1-30 have been rejected.

Claims 2, 17, 28, 29 and 30 have been cancelled without prejudice.

Claims 31 and 32 have been added.

**Claim Rejections: Double Patenting**

Claims 1-15 and 28-30 were rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,552,110 (Yalvac et al.). Claims 1-30 were rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,120,887 (Werenicz et al.).

While the conflicting claims of the references are not identical to the pending claims, it is alleged they are not patentably distinct from each other because the compositions are identical in scope and compositional limitations. The subsequent employment of the composition as a hot-melt adhesive and the production, thereof, by the simple mixing steps recited in the instant claims is further alleged to have been obvious steps within the skill of an artisan.

Applicant respectfully traverses this rejection. To reject a claimed invention based upon its obviousness over the prior art, the examiner must support such a rejection by establishing the invention's prima facie obviousness. The examiner must show where in the art cited there is a description of the claimed invention sufficient to have taught or suggested the invention to ordinarily skilled artisans of the time (see, e.g., ACS Hospital Systems, Inc., v. Montefiore Hospital, 221 USPQ 929, 933 (F. Cir. 1984); see also, In re Fine, 5 USPQ2d 1596 (F. Cir.

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1988)).

Evaluation of whether the cited documents provide the necessary description requires consideration of "(1) whether the prior art would have suggested to those of ordinary skill in the art they should make the claimed [invention] ... and (2) whether the prior art would have also revealed that in so making ... those of ordinary skill would have a reasonable expectation of success" (In re Vaeck, 20 USPQ2d 1438, 1442 (F.Cir. 1991)). "Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure" (In re Vaeck, *supra*). That is, "one cannot use hindsight reconstruction to pick and choose amongst isolated disclosures in the prior art to deprecate the claimed invention" (In re Fine, *supra* at 1600).

The claims at issue in Yalvac et al. fail to disclose using any of the compositions as a hot melt adhesive. Claims 1-16 of this reference teach a thermoplastic marking composition; the remaining claims, not cited in the Office Action, teach a method of marking a road. While Yalvac et al.'s specification describes use of the composition in a variety of coating, marking and painting applications, there is no suggestion to use such compositions as hot melt adhesives.

The Werenicz et al. reference merely relates to a fluid impermeable barrier layer in a disposable article, and that the applied coating has a low coating weight.

Applicant respectfully submits that the claims of the present pending application would not have been obvious in view of the teachings of either reference, and that Claims 1-30 define patentable subject matter. Accordingly, Applicant respectfully declines filing a terminal disclaimer at this stage of prosecution.

#### **Claim Rejections - 35 USC § 102(e)**

Claims 1-15 and 28-30 were rejected under 35 U.S.C. 102(e) as being anticipated

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by Yalvac et al., (U.S. Pat. No. 6,552,110). Claims 1-30 were similarly rejected as being anticipated by Werenicz et al., (U.S. Pat. No. 6,120,887).

In response, Applicant respectfully traverses these rejections because neither reference is an appropriate reference under 35 U.S.C. §102. In order to be a valid reference under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or impliedly, and any feature not directly taught must be inherently present. MPEP 706.02.

Applicant traverses the rejection of Claims 1 - 16 and 28-30 based on the Yalvac et al. reference. This reference fails to teach a hot melt adhesive composition, or method of producing a polymer composition as claimed in new Claims 31 and 32. Newly added Claim 31 comprises a combination of cancelled Claims 28 and 29, and newly added Claim 32 replaces cancelled Claim 30. Yalvac et al. merely discloses a thermoplastic composition for marking a road, and a method of marking a road using that composition. As will be described in greater detail in the response to the 35 U.S.C. §102(b) rejection, Claims 1 and 16 have been amended to further define embodiments of the invention, and properties of the homogeneous ethylene/alpha-olefin interpolymers and the hot melt adhesive composition. Claims 31 and 32 have been added as described above. Claims 2, 17, and 28-30 inclusive have been cancelled without prejudice.

Although Yalvac et al. may disclose a density range for the polymer employed in its marking composition, this density range is insufficient to anticipate the present pending claims because the reference does not disclose the other properties claimed, such as, for example, the number average molecular weights (Mn) of the polymers used in the composition, the Brookfield viscosity of the polymers or of the hot melt adhesive composition, or adhesive properties such as the PAFT and SAFT. Therefore, the Yalvac et al. reference is an improper reference because it fails to disclose all of the elements of the claimed invention. Claims 1-16 and 28-30 (now Claims 31-32) define patentable subject matter, and accordingly, the rejection of Claims 1-16, and 28-30 must respectfully be withdrawn.

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Applicant traverses the rejection of Claims 1 - 30 based on the Werenicz et al. reference for reasons similar to those described above regarding Yalvac et al. While Werenicz et al. may disclose a density range for the polymer employed in the barrier composition, this is insufficient to anticipate the present pending claims because the reference does not disclose the other properties claimed, such as, for example, the number average molecular weights (Mn) of the polymers used in the composition, the Brookfield viscosity of the polymers or of the hot melt adhesive composition, or adhesive properties such as the PAFT and SAFT. Therefore, Werenicz et al. is an improper reference because it fails to disclose all of the elements of the claimed invention, Claims 1-30 (now Claims 1-32) define patentable subject matter, and accordingly, the rejection of Claims 1-30 must respectfully be withdrawn.

#### **Claim Rejections - 35 USC § 102(b)**

Claims 1, 16 and 25-28 were rejected under 35 U.S.C. 102(b) as being anticipated by Tse et al., (U.S. Pat. No. 5,548,014), Dubois et al., (U.S. Pat. No. 6,107,430), or Baetzold et al., (U.S. Pat. No. 6,221,448). It is alleged that each reference teaches the manufacture of hot-melt adhesives of a homogeneous ethylene/alpha-olefin interpolymers with tackifier resins, within the ranges recited and claimed herein, for use in cellulosic substrate applications.

Applicant respectfully traverses these rejections under 35 U.S.C. §102(b). In order to be a valid reference under 35 U.S.C. §102(b), the reference must teach every aspect of the claimed invention either explicitly or impliedly, and any feature not directly taught must be inherently present. MPEP 706.02.

Applicant traverses the rejection of Claims 1, 16 and 25-28 based on the Tse et al. reference (U.S. Pat. No. 5,548,014). This reference's Abstract describes hot melt adhesive compositions in which the ethylene/alpha-olefin copolymer has a weight average molecular weight (Mw) ranging from about 20,000 to about 100,000. The present pending Claims 1, 16 and 25-28 do not claim a weight average molecular weight for the ethylene/alpha-olefin

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copolymer employed, nor claim any particular molecular weight distribution ("MWD", defined at col. 3, lines 26-47 of Tse et al.).

The citation of Tse et al.'s col. 5, lines 3-21 is also inappropriate. The reference discloses that two ethylene/alpha-olefin copolymers are employed in its' composition, but does not disclose the complete range of ethylene/alpha-olefin interpolymers employed in Applicant's claimed invention (see Claims 1, 16 and added Claims 31-32). Accordingly, because the Tse et al. reference fails to disclose every aspect of the claimed invention, Tse et al. is an improper reference under 35 U.S.C. §102(b), and the rejection of Claims 1, 16 and 25-28 must therefore be withdrawn.

Column 5 (lines 1 - 10) of the Dubois et al. reference discloses a hot melt adhesive composition comprising from 20 percent to 65 percent of at least one homogeneous ethylene/alpha-olefin interpolymer. As stated above regarding the Tse et al. reference, Dubois et al. simply does not disclose the range of ethylene/alpha-olefin interpolymers employed in Applicant's claimed invention (see Claims 1, 16 and 31-32).

Claim 1 has been amended to incorporate the contents of Claim 2 solely in order to facilitate the prosecution of this application. Claim 2 has been cancelled so as not to depend from a cancelled Claim. Similarly, Claim 16 has been amended, and Claim 17 cancelled.

Those Claims (21, 23 and 26) dependent upon Claim 17 have been amended so as not to depend from a cancelled Claim.

New Claims 31 and 32 have been presented. Claim 31 combines the language of Claims 28 and 29, and Claim 32 is a replacement for Claim 29.

Claims 28-30 have been cancelled to avoid duplication.

The paragraph in Dubois et al. that bridges column 23 to column 24 lists several components that can be added to the adhesives disclosed in the reference, Claim 25 contains other additives and agents that are not included by this reference, therefore rendering Dubois et

al. an improper reference under 35 U.S.C. §102(b).

The Baetzold et al. reference is inappropriate. The Abstract merely defines a cold seal composition comprising from about 10 wt-% to 100 wt-% of at least one homogeneous ethylene/ $\alpha$ -olefin interpolymer, and this composition has certain rheological properties

Baetzold (at col. 1, lines 24-35) merely defines a cold seal adhesive, and selected packaging types for which it can be employed. The "various packaging applications" recited are not encompassed by any of Applicant's claims. Applicant's invention is directed to hot melt adhesive applications; the reference's citation defines their invention as a "cohesive adhesive" or "cold seal", that is, an adhesive which adheres to itself with pressure, and which the inventors of the reference are intent on using at low temperatures

Column 3, lines 62-67 of the Baetzold et al. reference define a homogeneous ethylene/ $\alpha$ -olefin interpolymer, but has no bearing on any of Applicant's claims.

The citations on col.5 are also inappropriate because although polymer properties such as number average molecular weight and density are described, these data alone are insufficient to conclude that an adhesive as claimed by Applicant would also have the Brookfield viscosities, number average molecular weight, and adhesive properties, such as the PAFT and SAFT, claimed in the present application.

The reference defines a tackifier and describes tackifier properties are recited at col. 8, lines 23-44, but this citation also has no relationship to any of Applicant's claims, but merely describing a tackifier has no relationship to how it is described in Applicant's claims. .

While col. 9, lines 50-63 lists several components that can be added to the cold seal adhesives of the reference, Claims 10 and 25 contain other additives and agents that are not included by this reference, therefore rendering Baetzold et al. an improper reference under 35

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U.S.C. §102(b).

Accordingly, Applicant respectfully requests that the rejections of these claims based upon 35 U.S.C. §102(b) be withdrawn.

#### **Claim Amendments**

Claims 8, 9 and 23 have been amended to correct grammatical errors.

Claim 10 has been amended to depend from Claim 9 instead of Claim 12, as inadvertently written in the Claims as filed because of a typographical error.

Claims 21 and 23, originally dependent upon now cancelled Claim 17, have been amended to depend from Claim 16 so as not to depend from a cancelled Claim.

The spelling of homogeneous in the claims has been corrected. The basis for this amendment is at page 12, lines 11-12, p. 14, line 1 and p. 14, line 17 of the specification as originally filed, and numerous other locations within the specification.

#### **Conclusion**

Applicant thanks the Examiner for the thoughtful review of this application, and respectfully requests the Examiner review the pending Claims and to find that they define patentable subject matter. Thus, it is respectfully requested that the present pending Claims be allowed.

In the event that this Amendment does not place the application in condition for allowance, the Examiner is respectfully requested to telephone the undersigned in order that an attempt can be made to place the application in condition for allowance as expeditiously as possible.

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Respectfully submitted,



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